

REMARKS**Present Status of Application**

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, has rejected all claims 1-19. Claim 10 is amended herein, and claims 1-19 remain pending in the application.

Applicants submit that no new matter has been added by this amendment.

The rejection under §35 U.S.C. 103 (a)

The Office Action rejected claims 1-19 under 35 U.S.C. 103(a) as allegedly unpatentable over Jones et al. (U.S. Patent 5,519,585) in view of Chuang (U.S. Patent 6,469,912 B1). Applicants respectfully traverse the rejections for at least the reasons discussed below.

Independent Claims 1 and 10

Independent claim 1 recites:

1. A hatch for an electronic device, comprising:
a main body;
a thermal insulation layer disposed on the inner surface of the main body;
a conductive layer fully covering the surface of the thermal insulation layer;
an electrical insulation layer partially covering the conductive layer, leaving part exposed to dissipate heat from the electronic device.

Independent claim 10 recites:

10. A hatch for an electronic device, the electronic device having a housing, the hatch comprising:
a main body detachably disposed on the housing;
a thermal insulation layer disposed on a side of the main body, wherein the side is adjacent to heat-generating components;
a conductive layer covering the surface of the thermal insulation layer; and
an electrical insulation layer partially covering the conductive layer, leaving part of the conductive layer is exposed and heat from the component is insulated by the thermal insulation layer.

(*Emphasis added.*) Applicants respectfully submit that independent claims 1 and 10 patently define over the cited art for at least the reason that the cited art fails to disclose those features emphasized above.

In U.S. Patent 5,519,585, Jones discloses a “Sandwiched insulative/conductive layer EMI shield structure for printed circuit board”. Referring to Col. 3, lines 39-43, “the EMI shield 24 has a thin film polymer substrate portion 44 which, using a thermal/vacuum process, is laterally deformed to the shield shape shown in FIG. 3. The top side of the substrate 44 is metallized, preferably by electrostatically sputtering a metallic coating 46 thereon”. However, Jones failed to teach or suggest “the thermal insulation layer disposed on the main body of the hatch”, as claimed in independent claims 1 and 10 of the present application. Applicants note that the polymer substrate 44 in Jones’s patent is provided as an EMI shield structure, and it cannot be properly equated to the “thermal insulation layer” of the present application because Jones never discloses or suggests the polymer substrate 44 as a “thermal insulation layer”, such that “heat from the component is insulated by the thermal insulation layer” to prevent excessive temperature buildup on the underside of the main body.

Further, Jones also fails to teach the “hatch” as disclosed in the present application. Though Chuang appears to disclose a notebook computer having a cover member (hatch), he did not teach “the thermal insulation layer”, “the conductive layer”, or “the electrical insulation layer” as defined in claims 1 and 10 of the present application.

For at least these reasons, the rejections of claims 1 and 10 are misplaced and should be withdrawn.

Insofar as claims 2-9 and 11-19 depend from claims 1 and 10 respectively, these claims are also allowable over Jones and Chuang.

As a separate and independent basis for the patentability of claims 1 and 10 (and dependent claims 2-9 and 11-19), Applicants respectfully traverse the rejections as failing to identify a proper basis for combining the Jones and Chuang references. In combining these references to reject claim 1, the Office Action stated only that the combination would have been obvious "to reduce the cost and improve the effectiveness of EMI barriers." (Office Action, page 3, last three lines). In combining these references to reject claim 10, the Office Action stated only that the combination would have been obvious "to provide and an access port for the user to replace components without having to dismantle the electronic device." (Office Action, page 6). These alleged motivations are clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also

requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a hatch for an electronic device, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").


Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

In the present situation, the cited motivation set forth by the Office Action amounts to little more than an identification of the utility achieved by Applicants' invention. The utility of an invention cannot be properly cited as the suggestion or motivation for combining select teachings of the prior art. Instead, any cited motivation must come from the prior art itself.

If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By: 
Daniel R. McClure
Registration No. 38,962

Thomas, Kayden, Horstemeyer & Risley, LLP
100 Galleria Pkwy, NW
Suite 1750
Atlanta, GA 30339
770-933-9500